

RECEIVED
CENTRAL FAX CENTER

APR 27 2007

ROACH, BROWN, MCCARTHY & GRUBER, P.C.
1620 Liberty Building
Buffalo, New York 14202
(716) 852-0400
FAX
(716) 852-2535

TO: Commissioner for Patents - Petitions
Office

COMPANY: USPTO

FAX NO.: 1-571-273-8300

FROM: Kevin D. McCarthy

RE: 10/588,398

DATE: April 27, 2007

NUMBER OF PAGES TRANSMITTED: COVER + 7 = 8

MESSAGE:

PLEASE CONTACT _____ IMMEDIATELY IF ALL PAGES ARE NOT
RECEIVED OR IF WE ARE DISCONNECTED DURING TRANSMISSION.

NOTICE TO RECIPIENT: The information contained in this facsimile transmission is attorney privileged and confidential information intended solely for the use of the addressee named above. If the reader of this message is not the intended recipient, you are hereby notified that any dissemination, distribution or copying of this communication is strictly prohibited. If you have received this communication in error, please immediately notify us by telephone and return the original facsimile transmission to us by mail.
Thank you.

RECEIVED
CENTRAL FAX CENTER

APR 27 2007

Certificate of Mailing or Transmission

I, the undersigned, hereby certify that this correspondence along with other possible documents has been deposited with the U.S. Postal Service by first class mail, postage pre-paid, in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, or facsimile transmitted to the U.S. Patent and Trademark Office on April 27, 2007.

Typed Name: Kevin D. McCarthy
Date: April 27, 2007

Patent 0-06-172 (17660/US/04 CIP)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: Bron et al.
Serial no.: 10/588,398
Int. Filed: May 30, 2005
Submitted to USPTO: August 3, 2006
Title: SCORCH PREVENTION IN FLEXIBLE
POLYURETHANE FOAMS
Examiner: N/A
Art Unit: N/A

**Petition to Accept an Unintentionally Delayed Claim under 35 U.S.C. 120, 121, or
365(c) for the Benefit of a Prior-Filed Application
And Amendment to Specification**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir/Madam:

On April 24, 2007, the USPTO mailed us a communication informing us that a "Notification of Missing Requirements under 35 U.S.C. 371 In the United States Designated/Elected Office (DO/EO/US)" document was vacated. See Exhibit A. In a footnote, the USPTO wrote "the requirements for 37 CFR 1.78(a)(2) do not appear to have been met." That rule reads as follows:

(2)(i) Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending nonprovisional applications or international applications designating the United States of America must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (see § 1.14).

(ii) This reference must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35 U.S.C.

Serial no.: 10/588,398
Page 2

111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application. If the later-filed application is a nonprovisional application which entered the national stage from an international application after compliance with 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371 (b) or (f) in the later-filed international application or sixteen months from the filing date of the prior-filed application. These time periods are not extendable. Except as provided in paragraph (a)(3) of this section, the failure to timely submit the reference required by 35 U.S.C. 120 and paragraph (a)(2)(i) of this section is considered a waiver of any benefit under 35 U.S.C. 120, 121, or 365(c) to such prior-filed application. The time periods in this paragraph do not apply if the later-filed application is:

- (A) An application for a design patent;
- (B) An application filed under 35 U.S.C. 111 (a) before November 29, 2000; or
- (C) A nonprovisional application which entered the national stage after compliance with 35 U.S.C. 371 from an international application filed under 35 U.S.C. 363 before November 29, 2000.

(iii) If the later-filed application is a non-provisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76), or the specification must contain or be amended to contain such reference in the first sentence(s) following the title.

(iv) The request for a continued prosecution application under § 1.53(d) is the specific reference required by 35 U.S.C. 120 to the prior-filed application. The identification of an application by application number under this section is the identification of every application assigned that application number necessary for a specific reference required by 35 U.S.C. 120 to every such application assigned that application number.

Applicant admits it did not submit any amendment to the specification to claim priority under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed copending non-provisional application or international application designating the United States of America within the time period set forth in 37 CFR 1.78(a)(2). The failure to do so was unintentional because it was believed the application was properly filed under the PCT protocols. The USPTO has established a rule in which the claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed copending non-provisional application or international application designating the United States of America may be accepted if the reference identifying the prior-filed application by application number or international application number and international filing date was unintentionally delayed. That rule is found at 37 CFR 1.78(a)(3), which reads as follows:

(3) If the reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section is presented after the time period provided by paragraph (a)(2)(ii) of this section, the claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed copending non-provisional application or international application

Serial no.: 10/588,398
Page 3

designating the United States of America may be accepted if the reference identifying the prior-filed application by application number or international application number and international filing date was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed application must be accompanied by:

- (i) The reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section to the prior-filed application, unless previously submitted;
- (ii) The surcharge set forth in § 1.17(t); and
- (iii) A statement that the entire delay between the date the claim was due under paragraph (a)(2)(ii) of this section and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

To comply with 37 CFR 1.78(a)(3); applicant submits the following:

- I) Please enter the following amendment prior to the first full paragraph of the application:

Claim of Priority:

This application claims priority as a continuation-in-part of international application no. PCT/IL2005/000554 filed on May 30, 2005 (and which designated the US); which claims priority to Israeli patent application no. 162450 that was filed on June 10, 2004.

- II) Form 2038 for \$1,370 is enclosed, the charge specified for § 1.17(t).

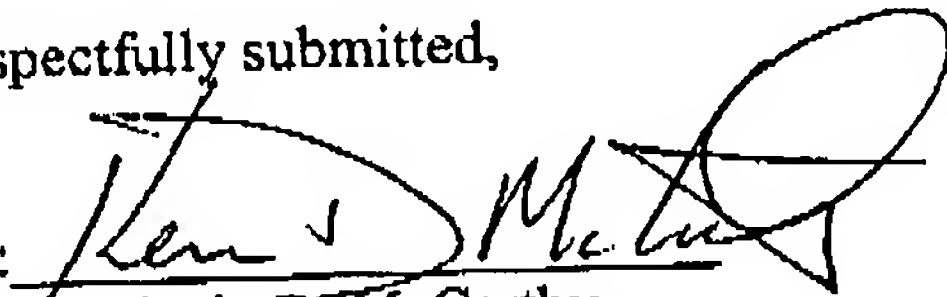
III) Applicant did not amend the specification within the allotted time periods because the applicant believed the application was properly filed under the PCT protocols only to realize that the addition of inventors violate a PCT rule. It was only when the PCT office ruled in the April 24, 2007 communication that this application should have been filed under 35 USC 111(a) on April 24, 2007 (received on April 27, 2007) did we realize the claim was not properly submitted.

As can be ascertained by the certificate of mailing and the date we received the April 24, 2007 communication, we have not delayed filing this petition.

It is respectfully requested that this petition be granted.

Respectfully submitted,

By:


Kevin D. McCarthy
Registration No. 35,278

Date: April 27, 2007

Roach Brown McCarthy & Gruber, P.C.
1620 Liberty Building
Buffalo, New York 14202
(716) 852-0400
e-mail: kdmccarthy@roachbrown.com

Serial no.: 10/588,398
Page 4

Exhibit A



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

24 APR 2007

KEVIN D. MCCARTHY
ROACH BROWN MCCARTHY & GRUBER, P.C.
1620 LIBERTY BUILDING
BUFFALO, NY 14202

In re Application of BRON et al
U.S. Application No.: 10/588,398
PCT Application No.: PCT/IL2005/000554
Int. Filing Date: 30 May 2005
Priority Date Claimed: 10 June 2004
Attorney Docket No.: 0-06-172
For: SCORCH PREVENTION IN FLEXIBLE
POLYURETHANE FOAMS

COMMUNICATION

This is in response to applicant's correspondence filed 16 March 2007.

BACKGROUND

On 30 May 2005, applicant filed international application PCT/IL2005/000554, which claimed priority of an earlier Israel application filed 10 June 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 22 December 2005. The thirty-month period for paying the basic national fee in the United States expired on 10 December 2006.

On 03 August 2006, applicant filed application papers in the USPTO including, *inter alia*, a Transmittal Letter to the United States Designated/Elected Office (DO/EO/US) Concerning a Submission Under 35 U.S.C. 371 (Form PTO-1390).

On 20 February 2007, the USPTO mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905).

On 16 March 2007, applicant filed the present response.

DISCUSSION

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). The official USPTO Notice published in the Official Gazette at 1077 OG 13

-2-

Application Number: 10/588,398

entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states in relevant part:

The Patent and Trademark Office is continuing to receive application papers which do not clearly identify whether the papers (1) are being submitted to enter the national stage of the Patent Cooperation Treaty (PCT) under 35 U.S.C. 371 or (2) are being filed as a regular national application under 35 U.S.C. 111. . . .

If there are any conflicting instructions as to which sections of the statute (371 or 111) is intended the application will be accepted under 35 U.S.C. 111. (Emphasis added.)

Although Form PTO-1390, filed 03 August 2006 identified the application as a national stage application being filed under 35 U.S.C. 371, Form PTO-1390 is marked with the statement, "This application is a continuation-in-part of PCT application no. PCT/IL2005/000554, filed on May 30, 2005." Furthermore, the 03 August 2006 contained a preliminary amendment cover page which states, "Applicant acknowledges on the transmittal sheet that this application is a continuation-in-part of PCT application number PCT/IL2005/000554, filed on May 30, 2005."¹ Such statements are inconsistent with and would have contradicted any desire expressed in any papers that might have been filed to enter the national stage of the PCT under 35 U.S.C. 371. See MPEP 1893.03(a), which states, "A conflicting instruction will be present, for example, where applicant includes in the initial submission under 35 U.S.C. 371, . . . a benefit claim under 35 U.S.C. 120 to the international application." Because the 03 August 2006 submission was not clearly and unambiguously identified as a filing under 35 U.S.C. 371, the submission should have been treated as a submission under 35 U.S.C. 111(a).

CONCLUSION

The Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) mailed 20 February 2007 is hereby VACATED.

This application is being forwarded to the Office of Initial Patent Examination (OIPE) for processing as an application filed under 35 U.S.C. 111(a).

Bryan Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

Telephone: 571-272-3303
Facsimile: 571-273-0459

¹ Applicant is advised that the requirements of 37 CFR 1.78(a)(2) do not appear to have been met.